

REMARKS

Claims 1-18 are pending in the present application. By virtue of this response, claims 4-7 and 14-17 have been cancelled, and claims 1, 3, and 9 have been amended. No new matter has been added. Accordingly, claims 1-3, 8-13, and 18 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

CLAIM REJECTIONS UNDER 35 USC §112, SECOND PARAGRAPH

Claims 3-18 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As an initial matter, Applicants request clarification on whether or not claims 8, 12-13, and 18 are correctly included in the rejection because they depend from claim 1, which is not included in the rejection. Applicants have proceeded to address the rejection with respect to those claims specifically cited in the Office Action, i.e., claims 3, 4-7, 9, and 14-17, and request appropriate correction if this is incorrect.

Claim 3. With respect to claim 3, the Office Action states that the claim is vague and indefinite because it appears to use improper Markush language. Claim 3 has been amended to remove the Markush group language. Applicants submit that this amendment renders the rejection moot. Furthermore, the Office Action states that claim 3 is vague because it is unclear if the liquid-flowing layer and the base member are made of the same material, or if they are one and the same. Without acquiescing to the rejection, claim 3 has also been amended to recite that either of the base member and the liquid flowing layer may be made from plastics. Applicants submit that this amendment overcomes the rejection.

Accordingly, withdrawal of the rejection of claim 3 under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claims 4-7 and 14-17. The Examiner has rejected claims 4-7 and 14-17 because they allegedly do not recite positive limitations to the assay device of claim 1. Without acquiescing to the rejection, claims 4-7 and 14-17 have been cancelled, thereby rendering the rejection moot.

Claim 9. The Examiner contends that claim 9 is allegedly vague and indefinite because there is no support in the specification for more than two headrests at the opposite ends of the sheet. Applicants disagree, but to expedite prosecution have amended claim 9 to recite “two headrests.”

Thus, withdrawal of the rejection of claim 9, and claims 10-11, which depend therefrom, under 35 U.S.C. § 112, second paragraph is respectfully requested.

CLAIM REJECTIONS UNDER 35 USC §103(a)

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Robinson et al. (U.S. 5,726,064) in view of The Millipore Guide to Developing Test Strip (“Millipore Guide”). Specifically, the Office Action states Robinson et al. (“Robinson”) discloses the invention substantially as claimed, but that it fails to teach a base member. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a backing member such as taught by the Millipore Guide to the waveguide of Robinson for the advantages of an increase in tensile strength leading to easy handling.

Applicants disagree that the combined teachings of Robinson and the Millipore Guide support a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that when combined, the cited references must teach or suggest all the claim limitations.” See MPEP 2143.

Independent claim 1 has been amended to recite that the immobilized substance is disposed on the side of the light-permissible member by a spray-coating method and that the side of the light-permissible member is subjected to either of an electrostatic treatment and a film coating treatment. Support for these amendments is found at least at paragraphs 11 and 26 (for spray-coating) and paragraph 20 (for electrostatic or film coating treatment), of the specification as originally filed. Robinson describes a device for assaying a ligand in a liquid sample, but does not

teach a spray-coating method or an electrostatic or film coating treatment to a light-permissible member. The Millipore Guide describes devices and methods for immunochromatography, but also does not teach a spray-coating method or an electrostatic or film coating treatment to a light-permissible member. Given that the Millipore Guide does not cure the defect in Robinson, Applicants assert that a *prima facie* case of obviousness has not been established.

Accordingly, withdrawal of the rejection of claim 1, as amended, under 35 U.S.C. § 103(a), and claims 2-3, 8-13, and 18, which depend therefrom, is respectfully requested.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 577892000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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